

1 THE OPINION IN SUPPORT OF THE DECISION BEING ENTERED TODAY WAS NOT  
2 WRITTEN FOR PUBLICATION AND IS NOT BINDING PRECEDENT OF THE BOARD.  
3

4 Paper 114  
5

6 Filed: 29 January 2007  
7

8 Filed by Motions Panel  
9 Mail Stop Interference  
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15 UNITED STATES PATENT AND TRADEMARK OFFICE  
16

17  
18  
19 BEFORE THE BOARD OF PATENT APPEALS  
20 AND INTERFERENCES  
21

22  
23 JOSEPH A. ROSSIN and WILLIAM B. FEAVER  
24 Junior Party  
25 (Patent 6,673,326),  
26

27 v.  
28

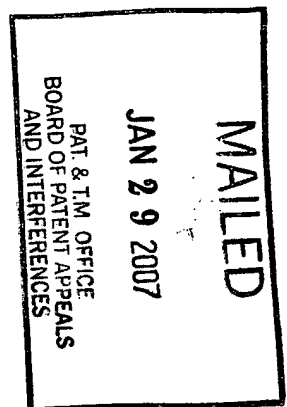
29 SHUICHI KANNO, TOSHIAKI ARATO,  
30 SHINZO IKEDA, KEN YASUDA, HISAO YAMASHITA,  
31 SHIGERU AZUHATA, SHIN TAMATA, and KAZUYOSHI IRIE  
32 Senior Party  
33 (Application 10/676,013).  
34

35  
36 Patent Interference No. 105,402 (McK)  
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38  
39 Before FRED E. McKELVEY, Senior Administrative Patent Judge, and RICHARD E.  
40 SCHAFFER and ADRIENE LEPIANE HANLON, Administrative Patent Judges.  
41

42 HANLON, Administrative Patent Judge.  
43

44  
45 MEMORANDUM OPINION  
46 BD.R. 125(a)  
47  
48



1           I.       Introduction

2           Junior party Rossin filed a substantive motion to be accorded an earlier  
3 constructive reduction to practice (Rossin Substantive Motion 4, Paper 40) and a  
4 substantive motion for judgment (Rossin Substantive Motion 6, Paper 41). Junior party  
5 Rossin also filed a miscellaneous motion to issue a Certificate of Correction (Rossin  
6 Miscellaneous Motion 8, Paper 38) and a miscellaneous motion to exclude evidence  
7 (Rossin Miscellaneous Motion 10, Paper 91).

8           Senior party Kanno filed three substantive motions to redefine the scope of the  
9 interference (Kanno Substantive Motion 3, Paper 42; Kanno Corrected Substantive  
10 Motion 4, Paper 76; and Kanno Corrected Substantive Motion 5, Paper 77)<sup>1</sup>, a  
11 substantive motion for judgment (Kanno Corrected Substantive Motion 2, Paper 75)<sup>2</sup>, and  
12 a substantive motion to be accorded an earlier constructive reduction to practice (Kanno  
13 Substantive Motion 1, Paper 44). Kanno also filed an uncontested miscellaneous motion  
14 (Kanno Miscellaneous Motion 1, Paper 30) and a miscellaneous motion to exclude  
15 evidence (Kanno Miscellaneous Motion 6, Paper 94).

16           Oral argument was heard on November 15, 2006. Both parties were represented  
17 by counsel at the hearing. See Paper 107. A transcript of the oral argument has been  
18 filed and is of record in the interference.<sup>3</sup> Paper 109.

19           In a MEMORANDUM OPINION and ORDER, Kanno Substantive Motion 3 to  
20 redefine the scope of the interference has been granted, and Kanno Corrected Substantive

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<sup>1</sup> Kanno Corrected Substantive Motion 4 (Paper 76) replaces Kanno Substantive Motion 4 (Paper 37).  
Kanno Corrected Substantive Motion 5 (Paper 77) replaces Kanno Substantive Motion 5 (Paper 36).

<sup>2</sup> Kanno Corrected Substantive Motion 2 (Paper 75) replaces Kanno Substantive Motion 2 (Paper 43).

<sup>3</sup> A letter correcting certain portions of the transcript has also been filed and is of record in the interference.  
Paper 110.

1 Motions 4 and 5 to redefine the scope of the interference have been dismissed without  
2 prejudice. See Paper 111, pp. 15-19.

3 As for the Rossin substantive motion for judgment (Rossin Substantive Motion 6),  
4 an opposition to the motion has been deferred to time period 13. Paper 52. Therefore, as  
5 to Rossin Substantive Motion 6, the record is not complete for a decision on the merits,  
6 and a decision on Rossin Substantive Motion 6 is deferred.

7 The remaining Rossin motions (Rossin Substantive Motion 4 and Rossin  
8 Miscellaneous Motions 8 and 10) and the remaining Kanno motions (Kanno Substantive  
9 Motion 1, Kanno Corrected Substantive Motion 2, and Kanno Miscellaneous Motions 1  
10 and 6) are decided here.

11 II. Background

12 The following facts, as well as other facts set forth in this opinion, are believed to  
13 be supported by a preponderance of the evidence.

- 14 1. This interference was declared on December 13, 2005. Paper 1.
- 15 2. Junior party Rossin is involved in this interference based on U.S. Patent  
16 6,673,326, issued January 6, 2004. Paper 1, p. 4.
- 17 3. Rossin Patent 6,673,326 is based on Application 09/633,609 filed **August 7,**  
18 **2000**. Paper 1, p. 4.
- 19 4. Rossin has not been accorded priority benefit of any earlier filing dates. Paper 1,  
20 p. 4.
- 21 5. Rossin's real party in interest is Guild Associates, Inc., Dublin, Ohio. Paper 10.
- 22 6. Senior party Kanno is involved in this interference based on Application  
23 10/676,013, filed October 2, 2003. Paper 1, p. 5.

1       7. Kanno has been accorded priority benefit of the **January 9, 1998**, filing date of  
2       Application 09/005,006. Paper 1, p. 5.

3       8. Kanno's real party in interest is Hitachi, Ltd., Tokyo, Japan. Paper 5.

4       9. Count 1 is currently the only count in this interference. Paper 1, p. 7.

5       10. Count 1 reads as follows (Paper 1, p. 7):

6               A process for reducing the concentration of a sample comprising  
7       perfluorinated compounds,  
8               said process comprising contacting the sample with a  
9       catalyst under conditions such that the concentration of perfluorinated  
10       compounds in the sample is reduced,  
11               said catalyst consisting of (1) aluminum oxide ( $\text{Al}_2\text{O}_3$ ) and  
12       (2) an enhancer selected from the group consisting of nickel and cobalt.

13  
14       11. Claims 1-3 and 6-26 of the involved Rossin patent correspond to Count 1.

15       Paper 1, p. 7.

16       12. Claims 4, 5, and 27 of the involved Rossin patent do not correspond to Count 1.

17       Paper 1, p. 7.

18       13. Claims 22-25, 27-32, and 34-37 of the involved Kanno application correspond to  
19       Count 1. Paper 1, p. 7.

20       14. Claims 26 and 33 of the involved Kanno application do not correspond to

21       Count 1. Paper 1, p. 7.

22       III.    Kanno Corrected Substantive Motion 2

23       Kanno moves for judgment that Rossin claims 1-3 and 6-26 are unpatentable

24       under 35 U.S.C. § 102(b) or § 103(a) in view of Japanese Patent Publication

25       10-10192653 and/or Japanese Patent Publication 11-70322. Paper 75, p. 2. Rossin filed

26       an opposition. Paper 74. Kanno filed a reply. Paper 81.

1 As the movant, Kanno bears the burden of establishing that it is entitled to the  
2 relief sought in the motion. 37 CFR § 41.121(b) (2006). The applicable standard of  
3 proof is the preponderance of the evidence standard. Bruning v. Hirose, 161 F.3d 681,  
4 685-86, 48 USPQ2d 1934, 1938 (Fed. Cir. 1998).

5 A. Findings of fact

6 15. Japanese Patent Application Publication 10-192653 was published on **July 28,**  
7 **1998.** KX 1013, p. 1.<sup>4</sup>

8 16. Japanese Patent Application Publication 10-192653<sup>5</sup> is prior art to the involved  
9 Rossin patent under 35 U.S.C. § 102(b).

10 17. Japanese Patent Application Publication 11-70322 was published on **March 16,**  
11 **1999.** KX 1014, p. 1.

12 18. Japanese Patent Application Publication 11-70322<sup>6</sup> is prior art to the involved  
13 Rossin patent under 35 U.S.C. § 102(b).

14 19. Kanno argues that the '653 and '322 Japanese publications are not prior art to the  
15 involved Kanno application. Paper 75, pp. 17-18.

16 20. The involved Kanno application is a divisional application of Application  
17 09/005,006, filed January 9, 1998. KX 1012.

18 21. The specification of the involved Kanno application appears to be substantially  
19 identical to the specification of Application 09/005,006. KX 1012; RX 2061.

20 22. The effective filing date (i.e., filing date under 35 U.S.C. § 120) of the involved  
21 Kanno application is **January 9, 1998.**

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<sup>4</sup> Kanno Exhibits are cited as "KX 10XX." Rossin Exhibits are cited as "RX 20XX."

<sup>5</sup> Hereinafter "the '653 Japanese publication."

<sup>6</sup> Hereinafter "the '322 Japanese publication."

1        23. The publication date of the '653 Japanese publication is after the effective filing  
2        date of the involved Kanno application.

3        24. The publication date of the '322 Japanese publication is after the effective filing  
4        date of the involved Kanno application.

5        25. Claim 1 of the involved Rossin patent reads as follows (Paper 11, p. 2):

6                A process for reducing the concentration of perfluorinated  
7        compounds or hydrofluorocarbon compounds in a sample, the process  
8        comprising:  
9                contacting said sample with a catalyst to produce a reacted sample,  
10        wherein the catalyst consists of  $\text{Al}_2\text{O}_3$ , and one or more enhancers selected  
11        from the group consisting of nickel, cobalt, and sulfate.

12  
13        26. Perfluorinated compounds are defined as fully fluorinated compounds made of  
14        carbon, nitrogen, or sulfur, or mixtures thereof. RX 2022, col. 1, lines 18-20.

15        27. Hydrofluorocarbon compounds are defined as compounds made of hydrogen,  
16        fluorine, and carbon. RX 2022, col. 1, lines 27-28.

17        28. Claim 2 of the involved Rossin patent reads as follows (Paper 11, p. 2):

18                The process of claim 1, wherein the concentration of perfluorinated  
19        compounds and hydrofluorocarbon compounds in the reacted sample is  
20        less than the concentration of perfluorinated compounds and  
21        hydrofluorocarbon compounds in the sample.

22  
23        29. Claim 3 of the involved Rossin patent reads as follows (Paper 11, p. 2):

24                The process of claim 1, wherein the perfluorinated compounds comprise  
25        nitrogen trifluoride ( $\text{NF}_3$ ), tetrafluoromethane ( $\text{CF}_4$ ), hexafluoroethane  
26        ( $\text{C}_2\text{F}_6$ ), sulfur hexafluoride ( $\text{SF}_6$ ), octafluoropropane ( $\text{C}_3\text{F}_8$ ),  
27        decafluorobutane ( $\text{C}_4\text{F}_{10}$ ), or octafluorocyclobutane ( $\text{c-C}_4\text{F}_8$ ).  
28

29        30. The '322 Japanese publication discloses a process for decomposition treatment of  
30        compounds having fluorine as a halogen and a catalyst therefor. KX 1014, p. 6,  
31        lines 22-25.

- 1        31. Examples of the halogen compound include CF<sub>4</sub>, C<sub>2</sub>F<sub>6</sub>, SF<sub>6</sub>, and NF<sub>3</sub>. KX 1014,  
2        p. 10, lines 22-24.
- 3        32. The catalyst used in the decomposition process is Al (aluminum) in the form of an  
4        oxide. KX 1014, p. 10, line 26-p. 11, line 3.
- 5        33. Al may be used in combination with at least one component selected from Zn, Ni,  
6        Ti, Fe, Sn, Pt, Co, Zr, Ce, and Si. KX 1014, p. 11, lines 3-6.
- 7        34. In a specific embodiment, Al is used in combination with Ni. KX 1014, p. 2,  
8        lines 12-13.
- 9        35. The '322 Japanese publication discloses that a catalyst containing Al and at least  
10       one component selected from Zn, Ni, Ti, Fe, Sn, Pt, Co, Zr, Ce, and Si, enhances  
11       the decomposition rate compared with using Al alone. KX 1014, p. 11, lines  
12       17-20.
- 13       36. In these catalysts, Al is present in the form of an oxide (Al<sub>2</sub>O<sub>3</sub>), or a composite  
14       oxide of the added metal component(s). KX 1014, p. 11, lines 20-22.
- 15       37. The '322 Japanese publication also discloses that sulfate may be added to the  
16       catalyst to improve the performance of the catalyst. KX 1014, p. 12, lines 12-19.
- 17       38. The '653 Japanese publication discloses a process for the efficient decomposition  
18       treatment of a gas containing fluorine compounds such as C<sub>2</sub>F<sub>6</sub> and a catalyst  
19       material. KX 1013, p. 4, lines 9-12.
- 20       39. Fluorine compounds treated by the process disclosed in the '653 Japanese  
21       publication also include NF<sub>3</sub>. KX 1013, p. 7, lines 2-4.
- 22       40. The catalyst contains at least one of alumina, titania, silica, and zirconia.  
23       KX 1013, p. 6, lines 30-32.

- 1        41. The '653 Japanese publication discloses that it is possible to decompose the  
2        fluorine compound-containing gas with higher activity when at least one  
3        component selected from Si, Mg, Zr, W, Sn, Ce, Mn, Bi, and Ni is added to the  
4        catalyst. KX 1013, p. 7, lines 6-9.
- 5        42. Claim 6 of the involved Rossin patent reads as follows (Paper 11, p. 2):  
6        The process of claim 1, wherein the concentration of nickel in the catalyst  
7        is up to about 30 weight percent.  
8
- 9        43. Claim 7 of the involved Rossin patent reads as follows (Paper 11, p. 3):  
10       The process of claim 1, wherein the concentration of cobalt in the catalyst  
11       is up to about 30 weight percent.  
12
- 13       44. The '653 Japanese publication discloses that the catalyst may contain an oxide of  
14       Ni in an amount from 0.1 to 10% by weight. KX 1013, p. 7, lines 16-18.
- 15       45. The '322 Japanese publication discloses that the atomic ratio of Al : M (M= at  
16       least one of Zn, Ni, Ti, Fe, Sn, Co, Zr, Ce, Si) is preferably 50 to 99% by mole of  
17       Al and 50 to 1% by mole of M. KX 1014, p. 11, line 24-p. 12, line 1.
- 18       46. Catalyst 4 disclosed in the '322 Japanese publication contains Al oxide, Ni oxide  
19       and  $\text{NiAl}_2\text{O}_4$  composite oxide wherein the atomic ratio of Al:Ni is 91:9 (mole  
20       percent). KX 1014, p. 25, lines 3-6.
- 21       47. The atomic ratio of Al:Co in Catalyst 9 is 91:9 (mole percent). KX 1014, p. 27,  
22       lines 9-19.
- 23       48. Claim 8 of the involved Rossin patent reads as follows (Paper 11, p. 3):  
24       The process of claim 1, wherein the nickel is selected from the group  
25       consisting of nickel oxide, nickel nitrate, and nickel acetate.  
26
- 27       49. Claim 9 of the involved Rossin patent reads as follows (Paper 11, p. 3):



1       The process of claim 1, wherein the cobalt is selected from the group  
2       consisting of cobalt oxide, cobalt acetate, and cobalt nitrate.

3  
4       50. The '653 Japanese publication discloses that the catalyst may contain an oxide of  
5       Ni. KX 1013, p. 7, lines 16-18.

6       51. According to the '322 Japanese publication, Ni and Co are present in the form of  
7       oxides or composite oxides with Al. KX 1014, p. 11, lines 22-24.

8       52. The '322 Japanese publication also discloses that nickel nitrate can be used as the  
9       raw material for Ni. KX 1014, p. 15, lines 17-18.

10       53. Cobalt nitrate may also be used to prepare the disclosed catalysts. KX 1014,  
11       p. 27, lines 9-19.

12       54. Claim 16 of the involved Rossin patent reads as follows (Paper 11, p. 4):

13       The process of claim 1, wherein the contacting step is performed at a  
14       temperature of about 150° C. to about 900° C.

15  
16       55. Claim 17 of the involved Rossin patent reads as follows (Paper 11, p. 4):

17       The process of claim 1, wherein the contacting step is performed at a  
18       temperature of about 250° C. to about 700° C.

19  
20       56. Claim 18 of the involved Rossin patent reads as follows (Paper 11, p. 4):

21       The process of claim 1, wherein the contacting step is performed at a  
22       temperature of about 250° C. to about 500° C.

23  
24       57. The '653 Japanese publication discloses that the gas stream containing the  
25       halogen compound is contacted with the catalyst at a temperature of about 400 to  
26       about 800° C. KX 1013, p. 6, lines 24-30.

27       58. Above 800°C, a higher decomposition rate can be obtained but the catalyst will  
28       rapidly deteriorate. KX 1013, p. 9, lines 28-30.

29       59. Below 400°C, the decomposition rate will be lowered. KX 1013, p. 10, lines 1-2.

1       60. In a specific embodiment, the gas stream is contacted with the catalyst at 700°C.

2           KX 1013, p. 13, lines 9-10.

3       61. According to the '322 Japanese publication, the gas stream containing the halogen  
4       fluorine is contacted with the catalyst at a temperature of about 200 to 800° C.

5           KX 1014, p. 3, lines 3-11.

6       62. In one embodiment, the decomposition rate of SF<sub>6</sub> at a reaction temperature of  
7       550 to 700°C was 99% or more. KX 1014, p. 35, line 20-p. 36, line 10.

8       63. In another embodiment, NF<sub>3</sub> was decomposed at a rate of 99.9% at 400°C.

9           KX 1014, p. 37, lines 3-16.

10      64. Claim 19 of the involved Rossin patent reads as follows (Paper 11, p. 4):

11          The process of claim 1, wherein the sample further comprises oxygen or  
12          air.

13  
14      65. According to the '322 Japanese publication, the apparatus for practicing the  
15      disclosed process includes a means for supplying air or oxygen to the gas stream.

16          KX 1014, p. 16, lines 18-23.

17      66. In one embodiment, air is added to the gas stream to dilute the halogen  
18      compound. KX 1014, p. 20, lines 2-3.

19      67. The '322 Japanese publication also discloses that oxygen may be added to the gas  
20      stream. KX 1014, p. 12, lines 22-25.

21      68. The '653 Japanese publication discloses that a C<sub>2</sub>F<sub>6</sub> gas may be diluted with air.

22          KX 1013, p. 13, lines 4-5.

23      69. Claim 20 of the involved Rossin patent reads as follows (Paper 11, p. 4):

24          The process of claim 1, wherein the sample further comprises water.

1       70. The apparatus for practicing the process disclosed in the '322 Japanese  
2           publication includes a means for adding water vapor or water to the gas stream.  
3           KX 1014, p. 16, lines 25-26.

4       71. A specific embodiment is disclosed wherein water vapor is added to the gas.  
5           KX 1014, p. 20, lines 5-8.

6       72. The '322 Japanese publication also discloses that a high decomposition rate may  
7           be obtained by adding water to the halogen compound. KX 1014, p. 10, lines  
8           14-16.

9       73. The '653 Japanese publication discloses that steam may be added to a C<sub>2</sub>F<sub>6</sub> gas  
10          prior to treatment. KX 1013, p. 13, lines 5-6.

11      74. Claim 21 of the involved Rossin patent reads as follows (Paper 11, p. 4):

12          The process of claim 1, wherein the sample further comprises a  
13          hydrocarbon.

14  
15      75. The '653 Japanese publication discloses that a hydrocarbon may be added to the  
16          gas prior to treatment. KX 1013, p. 9, lines 3-12.

17      76. Claim 22 of the involved Rossin patent reads as follows (Paper 11, p. 4):

18          The process of claim 1, wherein the total concentration of perfluorinated  
19          compounds and hydrofluorocarbon compounds in the sample is about  
20          50,000 ppm or less.

21  
22      77. Claim 23 of the involved Rossin patent reads as follows (Paper 11, p. 4):

23          The process of claim 1, wherein the total concentration of perfluorinated  
24          compounds and hydrofluorocarbon compounds in the sample is about  
25          20,000 ppm or less.

26  
27      78. Claim 24 of the involved Rossin patent reads as follows (Paper 11, p. 5):

1       The process of claim 1, wherein the total concentration of perfluorinated  
2       compounds and hydrofluorocarbon compounds in the sample is about  
3       5,000 ppm or less.  
4

5       79. The '653 Japanese publication discloses that the  $C_2F_6$  concentration in the  
6       reaction gas is about 0.5%. KX 1013, p. 12, lines 13-14.

7       80. The '322 Japanese publication discloses that the concentration of the halogen  
8       compound in the reaction gas is about 0.5 to 1%. KX 1014, p. 20, lines 9-11.

9       81. Claim 25 of the involved Rossin patent reads as follows (Paper 11, p. 5):

10       The process of claim 1, further comprising removing catalyst poisons from  
11       the sample prior to the contacting step.  
12

13       82. According to the specification of the involved Rossin patent, catalyst poisons  
14       include silicon tetrafluoride. RX 2022, col. 7, lines 28-31.

15       83. According to one embodiment disclosed in the '322 Japanese publication, the  
16       fluorine gas is sprayed with water to remove impurities such as  $SiF_4$ , etc. in the  
17       gas prior to the contacting step. KX 1014, p. 21, lines 8-11.

18       84. Claim 26 of the involved Rossin patent reads as follows (Paper 11, p. 5):

19       The process of claim 1, further comprising removing hydrofluoric acid  
20       from the reacted sample.  
21

22       85. The '322 Japanese publication discloses that the catalyst converts the fluorine  
23       compound in the gas stream to hydrogen fluoride, and the hydrogen fluoride is  
24       removed by contacting the gas stream with water. KX 1014, p. 4, line 18-p. 5,  
25       line 3.

26       86. The '653 Japanese publication also discloses that the catalyst converts the fluorine  
27       in the gas stream to HF. KX 1013, p. 6, lines 24-30.

28       87. Thereafter, the formed HF is removed. KX 1013, p. 10, lines 3-6.

1 Other findings as necessary appear in the Discussion portion of this opinion.

2 Discussion

3 A claim is anticipated if each and every element as set forth in the claim is either  
4 expressly or inherently described in a single prior art reference. Verdegaal Bros., Inc. v.  
5 Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied,  
6 484 U.S. 827 (1987). In its motion, Kanno argues that Rossin claims 1-3, 6-9, and 16-26  
7 are anticipated by the '322 Japanese publication and/or the '653 Japanese publication.<sup>7</sup>

8 Rossin argues that its involved Patent 6,673,326<sup>8</sup> is entitled to a presumption of  
9 validity over at least the '653 Japanese publication because an examiner considered an  
10 English abstract of the application as well as the complete Japanese document during  
11 prosecution of the application that matured into the '326 patent. Rossin further argues  
12 that the '322 Japanese publication is cumulative over the '653 Japanese publication and  
13 concludes that the presumption of validity applies to the '653 Japanese publication as  
14 well. Paper 74, p. 2.

15 Rossin's argument is not persuasive. First, the board is not bound by an  
16 examiner's ex parte decision in an interference. Cf. Sze v. Bloch, 458 F.2d 137, 140,  
17 173 USPQ 498, 500 (CCPA 1972); accord Heymes v. Takaya, 6 USPQ2d 1448, 1454  
18 (Bd. Pat. App. & Int.), reh'g denied, 6 USPQ2d 2055 (Bd. Pat. App. & Int. 1988).  
19 Second, the presumption of validity, with its high clear and convincing evidence standard

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<sup>7</sup> Kanno also argues that the '653 Japanese publication and/or the '322 Japanese publication anticipate Rossin claims 10-13 and 15. We do not reach this issue because Rossin claims 10-13 and 15, as well as Rossin claim 14, are unpatentable under 35 U.S.C. § 112, fourth paragraph. See pages 11-14 of the MEMORANDUM OPINION and ORDER (Paper 111).

<sup>8</sup> Hereinafter "the '326 patent."

1 of proof, is not applicable in this case. Bruning, 161 F.3d at 685-86, 48 USPQ2d at 1938;  
2 see also Bamberger v. Cheruvu, 55 USPQ2d 1523, 1525 (Bd. Pat. App. & Int. 1998).

3 In any event, Rossin argues that the '322 and '653 Japanese publications are not  
4 prior art to the involved Rossin '326 patent because the '326 patent is said to be entitled  
5 to the benefit under 35 U.S.C. § 120 of the May 30, 2000, filing date of Application  
6 09/580,889,<sup>9</sup> and the June 12, 1996, filing date of Application 08/662,129.<sup>10</sup> Paper 74,  
7 p. 1.

8 An applicant is entitled to claim the benefit under 35 U.S.C. § 120 of the filing  
9 date of an earlier application for a later claimed invention if the earlier application  
10 discloses the later claimed invention in the manner required by 35 U.S.C. § 112, first  
11 paragraph. In re Chu, 66 F.3d 292, 272, 36 USPQ2d 1089, 1093 (Fed. Cir. 1995).

12 The test for determining compliance with the written description requirement of  
13 35 U.S.C. § 112, first paragraph, is whether the disclosure of an application as originally  
14 filed would have reasonably conveyed to one of ordinary skill in the art that the inventor  
15 had possession of the later claimed subject matter. Vas-Cath, Inc. v. Mahurkar, 935 F.2d  
16 1555, 1563, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991). The claimed subject matter need  
17 not be described identically or literally for the application to satisfy the written  
18 description requirement of 35 U.S.C. § 112, first paragraph. In re Kaslow, 707 F.2d  
19 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). Nevertheless, the description must  
20 be sufficiently clear that one of ordinary skill in the art would have recognized from the

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<sup>9</sup> Hereinafter "the '889 application."

<sup>10</sup> Hereinafter "the '129 application."

1 disclosure that the applicant invented the later claimed subject matter. In re Wertheim,  
2 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976).

3 Claim 1 of the involved Rossin '326 patent reads as follows (Paper 11, p. 2):<sup>11</sup>

4 A process for reducing the concentration of **perfluorinated**  
5 compounds or **hydrofluorocarbon** compounds in a sample, the process  
6 comprising:  
7 contacting said sample with a catalyst to produce a reacted sample,  
8 wherein the catalyst consists of Al<sub>2</sub>O<sub>3</sub>, and one or more enhancers selected  
9 from the group consisting of nickel, cobalt, and **sulfate**. [Emphasis  
10 added.]  
11

12 Perfluorinated compounds are defined as fully fluorinated compounds made of carbon,  
13 nitrogen, or sulfur, or mixtures thereof. RX 2022, col. 1, lines 18-20.

14 The '889 application was filed as a divisional application of the '129  
15 application,<sup>12</sup> and the original disclosures of both applications appear to be substantially  
16 identical. See RX 2078; RX 2082. Therefore, we focus our attention on the original  
17 disclosure of the '129 application.

18 The '129 application describes methods for decomposing perfluoroalkanes.  
19 Perfluoroalkanes are defined as a specific group of halogen-containing compounds  
20 consisting of straight, branched, and cyclic alkanes that are composed of **only** carbon and  
21 fluorine atoms. RX 2078, p. 4, lines 3-6. Perfluoroalkanes are a subgenus of the genus  
22 of perfluorinated compounds recited in claim 1 of the involved Rossin patent.

23 Rossin appears to recognize that the '129 application only provides literal support  
24 for perfluoroalkanes. Nevertheless, Rossin argues that one of ordinary skill in the art  
25 would have expected the described methods to effectively decompose other

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<sup>11</sup> All of the Rossin claims designated to correspond to Count 1 depend from claim 1.

<sup>12</sup> The '889 application was filed on May 30, 2000, more than one year after both Japanese publications were published.

1 perfluorinated compounds such as perfluorocarbons consisting of nitrogen and fluorine.

2 Paper 74, p. 3.

3 Specifically, Rossin argues that one of ordinary skill in the art would have  
4 recognized that perfluoroalkanes represent some of the most stable compounds known.  
5 See RX 2078, p. 2, lines 5-7; see also RX 2080, p. 373, right column, second paragraph  
6 (fluorocarbons are resistant to chemical attack because of “the great strength of the C-F  
7 bond and the high electronegativity of fluorine”). Rossin concludes that “if a process for  
8 decomposing perfluoroalkanes could be found, the rest would be comparatively easy.”

9 Paper 74, pp. 3-4.

10 It appears that Rossin is arguing that it would have been obvious to one of  
11 ordinary skill in the art to use the process described in the original disclosure of the ‘129  
12 application to decompose other perfluorinated compounds. As explained in Lockwood v.  
13 American Airlines Inc., 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997):

14 The question is not whether a claimed invention is an obvious variant of  
15 that which is disclosed in the specification. Rather, a prior application  
16 itself must describe an invention, and do so in sufficient detail that one  
17 skilled in the art can clearly conclude that the inventor invented the  
18 claimed invention as of the filing date sought.

19  
20 Significantly, Rossin has not directed us to any credible evidence which  
21 establishes that the original disclosure of the ‘129 application is sufficiently clear that one  
22 of ordinary skill in the art would have recognized from the disclosure that the applicants  
23 invented a process for decomposing the genus of perfluorinated compounds.

24 Similarly, Rossin recognizes that the ‘129 application does not provide literal  
25 support for a sulfate enhancer. Nevertheless, Rossin argues that the ‘129 application  
26 discloses that common acids “such as nitric, formic or acetic” may be added during



1 catalyst preparation. Rossin argues that “the listed acids are clearly non-limiting  
2 examples” and concludes that the disclosure “implicitly includes any common acid  
3 including sulfuric acid.” Paper 74, p. 4.

4 Rossin has failed to direct us to any credible evidence which establishes that one  
5 of ordinary skill in the art would have recognized that the description of nitric, formic,  
6 and acetic acid “implicitly” describes sulfuric acid and a sulfate enhancer. See In re  
7 Schulze, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965) (arguments in the brief do  
8 not take the place of evidence in the record). Furthermore, to the extent that a sulfate  
9 enhancer is not expressly described but may have been obvious in view of the original  
10 disclosure of the ‘129 application, mere obviousness is not the standard for the written  
11 description requirement of 35 U.S.C. § 112, first paragraph.

12 Finally, claim 1 recites a process for reducing the concentration of perfluorinated  
13 compounds or **hydrofluorocarbon** compounds in a sample. In its opposition, Rossin has  
14 failed to address whether the original disclosure of the ‘129 application describes a  
15 process for reducing hydrofluorocarbon compounds. At the very least, we find that there  
16 is no literal support in the original disclosure of the ‘129 application for a process for  
17 reducing hydrofluorocarbon compounds. Additionally, Rossin has not directed us to any  
18 credible evidence which would tend to show that one of ordinary skill in the art would be  
19 informed that the disclosed process is applicable to hydrofluorocarbon compounds.

20 For the reasons set forth above, the original disclosure of the ‘129 application  
21 does not describe a process for reducing the genus of **perfluorinated** compounds or  
22 **hydrofluorocarbon** compounds. In addition, the original disclosure of the ‘129  
23 application does not describe a **sulfate** enhancer. Therefore, the involved Rossin patent

1 is not entitled to the benefit under 35 U.S.C. § 120 of the filing date of the '129  
2 application.

3 The original disclosure of the '889 application appears to be substantially  
4 identical to the original disclosure of the '129 application, and Rossin has not directed us  
5 to any differences, significant or otherwise, in the two disclosures. Therefore, for the  
6 same reasons that the involved Rossin patent is not entitled to the benefit under 35 U.S.C.  
7 § 120 of the filing date of the '129 application, the involved Rossin patent is also not  
8 entitled to the benefit under 35 U.S.C. § 120 of the filing date of the '889 application.  
9 Since Rossin is not entitled to the benefit under 35 U.S.C. § 120 of the filing dates of the  
10 '129 and '889 applications, the '653 and '322 Japanese publications are prior art under  
11 35 U.S.C. § 102(b) to the involved Rossin patent.

12 As for claim 16, Rossin argues that the Japanese publications exclude the coolest  
13 and warmest temperatures recited in Rossin claim 16. Paper 74, p. 9.

14 Rossin claim 16 recites that the contacting step is performed at a temperature of  
15 "about 150° C. to about 900° C." Paper 11, p. 4. The '653 Japanese publication discloses  
16 that the contacting step is performed at a temperature of about 400 to about 800° C.  
17 KX 1013, p. 6, lines 24-30. The '322 Japanese publication discloses that the contacting  
18 step is performed at a temperature of about 200 to 800° C. KX 1014, p. 3, lines 3-11.  
19 Both of these temperature ranges fall completely within the temperature range recited in  
20 Rossin claim 16. See Atofina v. Great Lakes Chemical Corp., 441 F.3d 991, 999, 78  
21 USPQ2d 1417, 1423 (Fed. Cir. 2006) (Titanium Metals stands for the proposition that an  
22 earlier species reference anticipates a later genus claim).

1           Furthermore, the '653 Japanese publication discloses a specific embodiment  
2   wherein the contacting step is performed at 700°C, and the '322 Japanese publication  
3   discloses a specific embodiment wherein the contacting step is performed at 400°C.  
4   KX 1013, p. 13, lines 9-10; KX 1014, p. 37, lines 3-16. See Wertheim, 541 F.2d at 267,  
5   191 USPQ at 100 (the disclosure in the prior art of any value within a claimed range is an  
6   anticipation of the claimed range).

7           For the reasons set forth above, both Japanese publications anticipate Rossin  
8   claim 16.

9           As for claim 21, Rossin argues that the '322 Japanese publication fails to  
10   anticipate or render obvious Rossin claim 21. Paper 74, p. 10.

11          Claim 21 recites "[t]he process of claim 1, wherein the sample further comprises a  
12   hydrocarbon." Paper 11, p. 4. The '653 Japanese publication clearly discloses that a  
13   hydrocarbon may be added to the gas stream prior to treatment. KX 1013, p. 9, lines  
14   3-12. Therefore, the '653 Japanese publication anticipates Rossin claim 21.

15          As for claim 22, Rossin argues that the '653 and '322 Japanese publications fail to  
16   disclose the range recited in claim 22. Paper 74, pp. 11-12.

17          Claim 22 recites that the total concentration of perfluorinated compounds and  
18   hydrofluorocarbon compounds in the sample is about 50,000 ppm or less. Paper 11, p. 4.  
19   This range converts to 5% or less. The '653 Japanese publication discloses that the C<sub>2</sub>F<sub>6</sub>  
20   concentration in the reaction gas is about 0.5%. KX 1013, p. 12, lines 13-14. This  
21   amount anticipates Rossin claim 22. See Wertheim, 541 F.2d at 267, 191 USPQ at 100  
22   (the disclosure in the prior art of any value within a claimed range is an anticipation of  
23   the claimed range).

1           Similarly, the '322 Japanese publication discloses that the concentration of the  
2   halogen compound in the reaction gas is about 0.5 to 1.0%. KX 1014, p. 20, lines 9-11.  
3   This range also anticipates claim 22. See Atofina, 441 F.3d at 999, 78 USPQ2d at 1423  
4   (Titanium Metals stands for the proposition that an earlier species reference anticipates a  
5   later genus claim).

6           Finally, Rossin argues that the '653 and '322 Japanese publications are prior art to  
7   the involved Kanno application because the application was filed after the publication  
8   dates of the '653 and '322 Japanese publications.

9           The effective filing date (i.e., filing date under 35 U.S.C. § 120) of the involved  
10   Kanno application is January 9, 1998, the filing date of Application 09/005,006.<sup>13</sup> This  
11   date is before the publication dates of the '653 and '322 Japanese publications. RX 2047.  
12   In its opposition, Rossin does not challenge whether the '006 application provides written  
13   description support for the involved Kanno claims. Rather, Rossin's only challenge to  
14   Kanno's benefit under 35 U.S.C. § 120 is based on an observation that a power of  
15   attorney filed in the '006 application was executed by Takeshi Yasuda who is not named  
16   as an inventor in that application. See RX 2062; RX 2064; Paper 74, pp. 14-15.

17           Rossin's argument is not persuasive. The involved Kanno application names the  
18   same inventors as the '006 application, including Ken Yasuda. See RX 2062; KX 1012,  
19   p. 1. Thus, it appears that the inventorship requirement of 35 U.S.C. § 120 has been met.  
20   To the extent that Rossin is challenging the inventorship of either application, a  
21   Declaration of Takeshi "Ken" Yasuda establishes that Ken Yasuda and Takeshi Yasuda  
22   are the same person. KX 1072, para. 13.

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<sup>13</sup> Hereinafter "the '006 application."

1 For the reasons set forth above, Kanno Corrected Substantive Motion 2 is granted.

2 IV. Rossin Substantive Motion 4

3 As to Count 1, Rossin moves to be accorded the benefit of (1) the May 30, 2000,  
4 filing date of Application 09/580,889, now Patent 6,426,443, and (3) the June 12, 1996,  
5 filing date of Application 08/662,129, now Patent 6,069,291. Paper 40.

6 Kanno Substantive Motion 3 seeking to substitute Count A for Count 1 has been  
7 granted. See MEMORANDUM OPINION and ORDER (Paper 111), pp. 15-18.

8 Therefore, Rossin Substantive Motion 4 is dismissed as moot.

9 V. Rossin Miscellaneous Motion 8

10 Rossin moves for the issuance of a Certificate of Correction in connection with  
11 the involved Rossin patent to recite a priority claim to (1) Application 09/580,889, filed  
12 May 30, 2000, now Patent 6,426,443, and (2) Application 08/662,129, filed June 12,  
13 1996, now Patent 6,069,291. Paper 38.

14 In Rossin Substantive Motion 4, Rossin moves to be accorded the benefit of the  
15 filing dates of these two applications. Paper 40. The involved Rossin patent does not  
16 recite a priority claim to either application. RX 2022. Therefore, a Certificate of  
17 Correction in the involved Rossin patent referring to the benefit sought in Rossin  
18 Substantive Motion 4 was deemed necessary to comply with the technical requirements  
19 of 35 U.S.C. § 120. Paper 31, p. 5.

20 Rossin Substantive Motion 4 has been dismissed. Therefore, it is not necessary to  
21 decide Rossin Miscellaneous Motion 8. Furthermore, as discussed above with respect to  
22 Kanno Corrected Substantive Motion 2, the involved Rossin patent is not entitled to the

1 benefit under 35 U.S.C. § 120 of either the May 30, 2000, filing date of the '889  
2 application or the June 12, 1996, filing date of the '129 application.

3 Rossin Miscellaneous Motion 8 is dismissed without prejudice to renewal in the  
4 event there are further proceedings in the interference.

5 VI. Kanno Miscellaneous Motion 1

6 Kanno moves to cancel claim 28 from the involved Kanno application and add  
7 claim 38. According to the motion, new claim 38 merely corrects a typographical error  
8 in claim 28. The motion is uncontested. See Paper 30.

9 Kanno Miscellaneous Motion 1 is granted.

10 VII. Kanno Substantive Motion 1

11 As to Count 1, Kanno moves to be accorded the benefit of (1) the January 14,  
12 1997, filing date of Japanese Patent Application 09-004349, and (2) the June 20, 1997,  
13 filing date of Japanese Patent Application 09-163717. Paper 44.

14 Kanno Substantive Motion 3 seeking to substitute Count A for Count 1 has been  
15 granted. See MEMORANDUM OPINION and ORDER (Paper 111), pp. 15-18.

16 Therefore, Kanno Substantive Motion 1 is dismissed as moot.

17 VIII. Rossin Miscellaneous Motion 10

18 Rossin moves to exclude from evidence certain exhibits filed and served by  
19 Kanno in the interference. Specifically, Rossin moves to exclude KX 1009, KX 1010,  
20 KX 1022, KX 1023, KX 1024, KX 1072, and KX 1073. Paper 91. Kanno filed an  
21 opposition. Paper 100. Rossin filed a reply. Paper 102.

22

23

1                   1.       KX 1009

2               KX 1009 is said to be a document from Chemical & Engineering News dated  
3   October 22, 2001, available on the internet. Paper 67, p. 2. Rossin argues that the  
4   document is hearsay within the meaning of Fed. R. Evid. 801 because it is an out of court  
5   statement offered to prove the truth of the matter asserted. Rossin also argues that none  
6   of the exceptions to the hearsay rule apply to the document. Paper 91, pp. 1-2; see also  
7   RX 2090. In response, Kanno argues that Rossin has failed to demonstrate that KX 1009  
8   lacks sufficient indicia of reliability such that it should be excluded as hearsay. Paper  
9   100, p. 9.

10           Kanno relies on KX 1009 in Kanno Substantive Motion 3 to establish the fact that  
11   “[t]he art of catalyst-enhanced reactions is generally unpredictable.” Paper 42, p. 9. We  
12   agree with Rossin that KX 1009 is an out of court statement offered to prove the truth of  
13   the matter asserted. See Fed. R. Evid. 801. We further note that the author of the  
14   document did not testify, and Kanno has not established that the document falls within an  
15   exception to the hearsay rule or is otherwise trustworthy within the meaning of Fed. R.  
16   Evid. 807.

17           Rossin Miscellaneous Motion 10 is granted with respect to KX 1009.<sup>14</sup>

18                   2.       KX 1010

19           KX 1010 is said to be the “Kanno Patent Tree.” Paper 67, p. 2. Rossin argues  
20   that the document is hearsay within the meaning of Fed. R. Evid. 801 because it is an out  
21   of court statement offered to prove the truth of the matter asserted. Rossin also argues

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<sup>14</sup> Although Rossin Miscellaneous Motion 10 is granted with respect to KX 1009, we nevertheless take official notice of the fact that catalytic activity is generally unpredictable. Cf. Corona Cord Tire Co. v. Dovan Chemical Co., 276 U.S. 358, 385 (1928) (see discussion with respect to claims 1, 5, and 9); Windemuth v. Brenner, 265 F.Supp. 487, 153 USPQ 112 (D.D.C. 1967).

1 that none of the exceptions to the hearsay rule apply to the document. Paper 91, p. 2; see  
2 also RX 2090.

3 Kanno argues that KX 1010 is merely a compilation of facts that are of public  
4 record. According to Kanno, the family tree is a visual aid for the Board illustrating the  
5 claimed relationships of the listed patents and patent applications. Kanno argues that  
6 Rossin has not challenged the accuracy of any of the information in KX 1010. Therefore,  
7 Kanno concludes that the Board should exercise its authority to take judicial notice of the  
8 facts in KX 1010. Paper 100, pp. 1-2.

9 Kanno relies on KX 1010 in Kanno Corrected Substantive Motion 2 to support its  
10 argument that the '653 and '322 Japanese publications are not prior art to Kanno. Paper  
11 75, pp. 17-18. KX 1010 is merely offered for the convenience of the Board and is  
12 nothing more than attorney argument. The underlying information in KX 1010 can be  
13 confirmed or denied by an examination of the official records of the United States Patent  
14 and Trademark Office.

15 Rossin Miscellaneous Motion 10 is denied with respect to KX 1010.

16 3. KX 1022

17 KX 1022 is said to be a document dated April 21, 2006, available on the  
18 "Wikipedia" web site. Paper 67, p. 3. Rossin argues that the document is hearsay within  
19 the meaning of Fed. R. Evid. 801 because it is an out of court statement offered to prove  
20 the truth of the matter asserted. Rossin also argues that none of the exceptions to the  
21 hearsay rule apply to the document. Specifically, with respect to the residual exception,  
22 Rossin argues that the reliability of the document is questionable and points to the  
23 Wikipedia web site which is said to state that Wikipedia is "the free encyclopedia that



1 anyone can edit.” Paper 91, pp. 2-3; see also RX 2090. In response, Kanno argues that  
2 Rossin has failed to demonstrate that KX 1022 lacks sufficient indicia of reliability such  
3 that it should be excluded as hearsay. Paper 100, p. 9.

4 Kanno relies on KX 1022 in Kanno Substantive Motion 3 to establish the fact that  
5 (Paper 42, p. 8):

6 With respect to the ultimate reaction products, for instance, the  
7 decomposition of hexafluorobenzene would yield benzene, which has an  
8 autoignition temperature within the range of temperatures contemplated  
9 for the decomposition reactions.

10  
11 We agree with Rossin that KX 1022 is an out of court statement offered to prove the truth  
12 of the matter asserted. See Fed. R. Evid. 801. We further note that the author of the  
13 document did not testify, and Kanno has not established that the document falls within an  
14 exception to the hearsay rule or is otherwise trustworthy within the meaning of Fed. R.  
15 Evid. 807.

16 Rossin Miscellaneous Motion 10 is granted with respect to KX 1022.

17 4. KX 1023

18 KX 1023 is said to be a document dated April 21, 2006, available on the internet.  
19 Paper 67, p. 3. Rossin argues that the document is hearsay within the meaning of Fed. R.  
20 Evid. 801 because it is an out of court statement offered to prove the truth of the matter  
21 asserted. Rossin also argues that none of the exceptions to the hearsay rule apply to the  
22 document. Specifically, with respect to the residual exception, Rossin argues that the  
23 document lacks any indicia of reliability and even fails to identify the document’s source.  
24 Paper 91, p. 3; RX 2090. In response, Kanno argues that Rossin has failed to

1 demonstrate that KX 1023 lacks sufficient indicia of reliability such that it should be  
2 excluded as hearsay. Paper 100, p. 9.

3 Kanno relies on KX 1023 in Kanno Substantive Motion 3 to provide factual  
4 support for certain properties of hexafluorobenzene. See Paper 42, pp. 7-8. We agree  
5 with Rossin that KX 1023 is an out of court statement offered to prove the truth of the  
6 matter asserted. See Fed. R. Evid. 801. We further note that the author of the document  
7 did not testify, and Kanno has not established that the document falls within an exception  
8 to the hearsay rule or is otherwise trustworthy within the meaning of Fed. R. Evid. 807.

9 Rossin Miscellaneous Motion 10 is granted with respect to KX 1023.

10 5. KX 1024

11 KX 1024 is said to be a document dated April 21, 2006, available on the internet.  
12 Paper 67, p. 3. Rossin argues that the document is hearsay within the meaning of Fed. R.  
13 Evid. 801 because it is an out of court statement offered to prove the truth of the matter  
14 asserted. Rossin also argues that none of the exceptions to the hearsay rule apply to the  
15 document. Specifically, with respect to the residual exception, Rossin argues that the  
16 document lacks any indicia of reliability and even fails to identify the document's source.  
17 Paper 91, pp. 3-4; see also RX 2090. In response, Kanno argues that Rossin has failed to  
18 demonstrate that KX 1023 lacks sufficient indicia of reliability such that it should be  
19 excluded as hearsay. Paper 100, p. 9.

20 Kanno relies on KX 1024 in Kanno Substantive Motion 3 to provide factual  
21 support for certain properties of tetrafluoromethane. See Paper 42, pp. 7-8. We agree  
22 with Rossin that KX 1024 is an out of court statement offered to prove the truth of the  
23 matter asserted. See Fed. R. Evid. 801. We further note that the author of the document

1 did not testify, and Kanno has not established that the document falls within an exception  
2 to the hearsay rule or is otherwise trustworthy within the meaning of Fed. R. Evid. 807.

3 Rossin Miscellaneous Motion 10 is granted with respect to KX 1024.

4 6. KX 1072

5 KX 1072 is a Declaration of Takeshi “Ken” Yasuda dated July 19, 2006. Rossin  
6 argues that the declaration is not relevant because the declaration (1) does not include an  
7 assertion that the declarant is an inventor of any portion of the subject matter claimed in  
8 the ‘006 application or the involved Kanno application and (2) does not include an  
9 assertion that the declarant actually signed any particular document in connection with  
10 the ‘006 application or the involved Kanno application. Paper 91, p. 5; see also RX 2091.

11 In the declaration, Takeshi Yasuda states that he is listed as an inventor in several  
12 U.S. patent documents, including the ‘006 application and the involved Kanno  
13 application. KX 1072, para. 9. Takeshi Yasuda also states that he signed documents  
14 related to the file histories of the U.S. patent documents. KX 1072, para. 13.

15 The declaration was offered to establish that Takeshi Yasuda and Ken Yasuda as  
16 referred to in the ‘006 application and the involved Kanno application are the same  
17 person. The declaration establishes this fact. Therefore, the declaration is relevant.

18 Rossin also argues that at least paragraph 13 of the declaration includes testimony  
19 that is not based on personal knowledge. Specifically, Rossin argues that nothing in the  
20 declaration indicates that the declarant had personal knowledge of the intent of Hitachi’s  
21 patent counsel with respect to listing the names Takeshi Yasuda and Ken Yasuda. Paper  
22 91, p. 6; see also RX 2091.

1           Significantly, the exhibit is not being offered to establish the intent of Hitachi's  
2   patent counsel. Rather, the declaration is being offered to establish the fact that Takeshi  
3   Yasuda and Ken Yasuda are the same person. Clearly, Takeshi "Ken" Yasuda has  
4   personal knowledge of that fact.

5           Finally, Rossin argues that the declaration is hearsay under Fed. R. Evid. 801  
6   because "it is an out of court statement offered to prove the truth of the matter(s)  
7   asserted." Paper 91, p. 6; see also RX 2091. To the contrary, the declaration is a  
8   statement made by the declarant while testifying at a trial or hearing, i.e., an interference  
9   proceeding before the United States Patent and Trademark Office.

10          Rossin Miscellaneous Motion 10 is denied as to KX 1072.

11                       7.     KX 1073

12          Rossin moves to exclude KX 1073. According to Rossin, KX 1073 was relied on  
13   in Kanno Reply 1. Paper 91, p. 7. Kanno Substantive Motion 1 has been dismissed.  
14   Therefore, it is not necessary to decide whether to exclude KX 1073.

15          Rossin Miscellaneous Motion 10 is dismissed as to KX 1073.

16                       IX.   Kanno Miscellaneous Motion 6

17          Kanno moves to exclude from evidence certain exhibits filed and served by  
18   Rossin in the interference. Specifically, Kanno moves to exclude RX 2001, RX 2014,  
19   RX 2015, RX 2016, RX 2035, RX 2036, RX 2059, RX 2076, RX 2080, RX 2081,  
20   RX 2083, RX 2084, RX 2086, and RX 2089. Paper 94. Rossin filed an opposition.  
21   Paper 98. Kanno filed a reply. Paper 101.

22          A motion to exclude must (1) identify where the objection to the admissibility of  
23   the evidence sought to be excluded was originally made in the record, (2) identify where

1 in the record the evidence sought to be excluded was relied upon by an opponent, and (3)  
2 refer to the objection by exhibit number. This information must be contained in the body  
3 of the motion. See 37 CFR § 41.155(c) (2006); Standing Order, ¶¶ 155.1.1 and 155.2.2.  
4 Kanno has not followed this procedure.<sup>15</sup> That being said, we have been able to locate  
5 the requisite information in Appendices 1 and 2 attached to Kanno Miscellaneous Motion  
6 6. We choose to exercise our discretion and decide Kanno Miscellaneous Motion 6.

7 1. RX 2001, RX 2014, RX 2015, RX 2016, RX 2035, RX 2036,  
8 RX 2059, and RX 2089  
9

10 Kanno objected to Rossin's reliance on RX 2001, RX 2014, RX 2015, RX 2016,  
11 RX 2035, RX 2036, RX 2059, and RX 2089 in connection with motions that have either  
12 been dismissed or deferred. See Paper 94, Appendix 2, pp. 1-3. Therefore, Kanno  
13 Miscellaneous Motion 6 is dismissed as to RX 2001, RX 2014, RX 2015, RX 2016,  
14 RX 2035, RX 2036, RX 2059, and RX 2089.

15 2. RX 2076

16 Rossin relies on RX 2076 in Rossin Opposition 2. See Paper 74, p. 4. Kanno  
17 argues that the exhibit is inadmissible because it is hearsay, has not been properly  
18 authenticated, and lacks any relevance to the present proceedings. Paper 94, p. 5; see  
19 also KX 1077. In its opposition, Rossin withdraws the exhibit. Paper 98, p. 7.<sup>16</sup>  
20 Therefore, Kanno Miscellaneous Motion 6 is dismissed as to RX 2076.

21  

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<sup>15</sup> In addition, we note that the comprehensive list of exhibits contained in Appendix 1 of Kanno Miscellaneous Motion 6 does not comply with the Standing Order. See Standing Order, ¶ 121.5.1.

<sup>16</sup> Rossin withdraws RX 2076 in favor of RX 2089, RX 2096, and RX 2097 and appears to supplement Rossin Opposition 2 with its discussion of RX 2089, RX 2096, and RX 2097 in Rossin Opposition 6. See Paper 98, pp. 7-8. RX 2089, RX 2096, and RX 2097 were not discussed in Rossin Opposition 2. Therefore, they are not entitled to consideration.

1                   3.     RX 2080

2             Kanno argues that RX 2080 is inadmissible because it has not been properly  
3     authenticated.<sup>17</sup> Paper 94, p. 6; see also KX 1077. Rossin points out that RX 2080 is a  
4     copy of an article from Chemical Reviews, a scientific periodical that is self-  
5     authenticating under Fed. R. Evid. 902(6). Paper 98, p. 8. We agree. See Fed. R. Evid.  
6     902(6) and 37 CFR § 41.153 (2006).

7             Kanno also argues that RX 2080 is inadmissible because it is hearsay. Paper 94,  
8     p. 6; see also KX 1077. However, Kanno has failed to explain why the exhibit is hearsay  
9     under the Federal Rules of Evidence. As the movant, Kanno bears the burden of showing  
10    by a preponderance of the evidence that it is entitled to have the evidence of the opposing  
11    party suppressed. This burden is not satisfied by a conclusory statement that RX 2080 is  
12    “hearsay” without a basis for the allegation.

13            Kanno Miscellaneous Motion 6 is denied as to RX 2080.

14                   4.     RX 2081

15            RX 2081 is an article from Catalysis Today. According to Kanno, RX 2081 is  
16    referred to in Rossin Opposition 2, Statement of Fact 151.<sup>18</sup> Paper 94, Appendix 2,  
17    pp. 2-3. Kanno argues that RX 2081 is inadmissible because it is irrelevant, is hearsay,  
18    and has not been properly authenticated. Paper 94, p. 6; see also KX 1077.

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<sup>17</sup> Kanno also argues that seven supplements attached to RX 2080 (A-F) are inadmissible as hearsay and have not been properly authenticated. Paper 94, p. 6. The copy of RX 2080 filed in the interference does not appear to have any supplements attached thereto. Therefore, we do not reach the issue of the admissibility of these supplements.

<sup>18</sup> Kanno also indicates that RX 2081 is relied on in Rossin Opposition 5. Paper 94, Appendix 2, pp. 2-3. However, Kanno Corrected Substantive Motion 5 has been dismissed. See MEMORANDUM OPINION and ORDER (Paper 111), p. 19.

1 First, Kanno does not indicate where in the body of Rossin Opposition 2 Rossin  
2 relies on RX 2081. Therefore, we cannot determine the relevance of the exhibit in  
3 relation to the arguments presented in the opposition. Second, Kanno has failed to  
4 explain why the exhibit is hearsay under the Federal Rules of Evidence. Finally,  
5 RX 2081 is a copy of an article from Catalysis Today, a scientific periodical that is self-  
6 authenticating under Fed. R. Evid. 902(6). See 37 CFR § 41.153 (2006).

7 Kanno Miscellaneous Motion 6 is denied as to RX 2081.

8 5. RX 2083

9 RX 2083 is said to be a National Science Foundation Grant Abstract. Paper 93,  
10 p. 8. It appears that the exhibit was downloaded from the internet. Kanno argues that the  
11 exhibit is inadmissible because it has not been properly authenticated. Paper 94, pp. 6-7.  
12 Rossin does not address the admissibility of RX 2083 in its opposition. See Paper 98.

13 We agree with Kanno that RX 2083 has not been properly authenticated. See  
14 Fed. R. Evid. 901. Furthermore, the document is not self-authenticating under Fed. R.  
15 Evid. 902.

16 Kanno Miscellaneous Motion 6 is granted as to RX 2083.

17 6. RX 2084

18 Kanno argues that RX 2084 is inadmissible because it is irrelevant, is hearsay,  
19 and has not been properly authenticated. Paper 94, p. 7; see also KX 1077. Rossin relies  
20 on RX 2084 to establish what one of ordinary skill in the art would have known as of  
21 June 12, 1996, the filing date of the '129 application. See Paper 74, p. 3. Kanno argues  
22 that the document is not relevant because there is no proof that the document was  
23 publicly available before June 12, 1996. See RX 2084 (bearing a date of October 2003).

1 In its opposition, Rossin attempts to supplement the teachings of RX 2084 with  
2 additional exhibits. However, Rossin does not direct us to any credible evidence which  
3 establishes that RX 2084 was publicly available as of June 12, 1996. For this reason, the  
4 exhibit is not relevant under Fed. R. Evid. 401. See also In re Glass, 492 F.2d 1228,  
5 181 USPQ 31 (CCPA 1974); In re Scarbrough, 500 F.2d 560, 182 USPQ 298 (CCPA  
6 1974).

7 Kanno Miscellaneous Motion 6 is granted as to RX 2084.

8 7. RX 2086

9 Kanno argues that RX 2086 is inadmissible because it is irrelevant, is hearsay,  
10 and has not been properly authenticated. Paper 94, pp. 7-8; see also KX 1077.  
11 According to Kanno, RX 2086 is referred to in Rossin Opposition 2, Statement of Fact  
12 155.<sup>19</sup> Paper 94, Appendix 2, p. 3.

13 It appears that Rossin relies on RX 2086 to establish the date NSF Award  
14 No. 9460097 (RX 2076) was publicly available. See Paper 74, p. 56, para. 155. Rossin  
15 withdrew RX 2076 in Rossin Opposition 6. Paper 98, p. 7. Therefore, it is not necessary  
16 to decide whether to exclude RX 2086.

17 Kanno Miscellaneous Motion 6 is dismissed as to RX 2086.

18 X. ORDER

19 Upon consideration of the record, and for the reasons given herein as well as in  
20 the MEMORANDUM OPINION and ORDER (Paper 111), it is hereby

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<sup>19</sup> Kanno also indicates that RX 2086 is relied on in Rossin Opposition 5. Paper 94, Appendix 2, p. 3. However, Kanno Corrected Substantive Motion 5 has been dismissed. See MEMORANDUM OPINION and ORDER (Paper 111), p. 19.



1                   ORDERED that Rossin Substantive Motion 4 is dismissed as moot; and it  
2 is

3                   FURTHER ORDERED that Rossin Substantive Motion 6 is deferred; and  
4 it is

5                   FURTHER ORDERED that Rossin Miscellaneous Motion 8 is dismissed  
6 without prejudice to renewal in the event there are further proceedings in the interference;  
7 and it is

8                   FURTHER ORDERED that Rossin Miscellaneous Motion 10 is  
9 dismissed-in-part, denied-in-part, and granted-in-part; and it is

10                  FURTHER ORDERED that Kanno Miscellaneous Motion 1 is granted;  
11 and it is

12                  FURTHER ORDERED that Kanno Substantive Motion 1 is dismissed as  
13 moot; and it is

14                  FURTHER ORDERED that Kanno Corrected Substantive Motion 2 is  
15 granted; and it is

16                  FURTHER ORDERED that Kanno Miscellaneous Motion 6 is dismissed-  
17 in-part, denied-in-part, and granted-in-part.

18

19

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1                    /ss/ Fred E. McKelvey                    )  
2                    FRED E. McKELVEY                    )  
3                    Senior Administrative Patent Judge                    )  
4                    )                    BOARD OF  
5                    /ss/ Richard E. Schafer                    )                    PATENT  
6                    RICHARD E. SCHAFER                    )                    APPEALS  
7                    Administrative Patent Judge                    )                    AND  
8                    )                    INTERFERENCES  
9                    /ss/ Adriene Lepiane Hanlon                    )  
10                    ADRIENE LEPIANE HANLON                    )  
11                    Administrative Patent Judge                    )  
12

13

14

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